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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,129	07/05/2000	Galen Rasche	LE9-00-051	4624

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LEXMARK INTERNATIONAL INC
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
LEXINGTON, KY 40550

EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 03/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/610,129

Applicant(s)
Galen Rasche et al.

Examiner
King Y. Poon

Art Unit
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 7, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-7, 9, 11- 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Itoh.

(U.S. Patent # 6,034,785)

Regarding claim 1: Itoh teaches a printer configuration, (fig. 2) comprising: a) a computer readable medium (recording medium, column 12 line 40-45) comprising data; b) a computer (fig. 2, 20 server, column 12, line 41) having access to the data on the computer readable medium; c) a communication link (the arrow between 42 and 20, fig. 1, column 13, lines 35-36, column 9, lines 60-65) connected to the computer; (fig. 2, column 9, lines 60-65, column 12, lines 60-65, column 6, lines 20-25); d) a photoprinter (digital print system 10, column 7, line 55) connected to the communication link and in communication with the computer, the photoprinter (digital print system 10, column 7, line 55) having a selection mechanism (22a, and 22b, column 9, lines 30-55) and having access to the data over the communication link (the line connecting 20 server

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and 42 memory, column 9, lines 55-65, column 10 lines 27-37) in response to a user's input to the selection mechanism on the photoprinter (digital print system 10, column 7, line 55).

Regarding claim 2: Itoh teaches a user interface (monitor 18, column 9 lines 35-55) on the photoprinter having a plurality of options selectable by a user with the selection mechanism.

Regarding claim 3: Itoh teaches wherein the options include downloading files from the computer (20) (column 9, lines 60-65, column 12, lines 60-65) uploading files to the computer (20) (column 10, lines 1-5) or printing files.

Regarding claim 4: Itoh teaches wherein the one or more files are presented on the user interface (18)(Column 10, lines 1-16, column 9, lines 29-55).

Regarding claim 5: Itoh teaches wherein the data comprises digital photographs (Column 8, lines 20-35).

Regarding claim 6: Itoh teaches wherein the data comprises executable code for running on the photoprinter (digital print system 10, column 7, line 55, Column 10, lines 38-52).

Regarding claim 7: Itoh teaches wherein the computer (20) is connected locally to the photoprinter (digital print system 10, column 7, line 55, Fig. 2).

Regarding claim 9: Itoh teaches wherein the computer (20) is a server (Column 12, lines 41).

Regarding claim 11: Itoh teaches a printer configuration, (fig. 2) comprising: a) a computer (20, fig. 2, server, column 12, line 41) having a plurality of digital photographs (Column 8, lines 20-35) on a computer readable medium; (recording medium, column 12, lines

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40-45) b) a communication link (the arrow between 42 and 20, fig. 1, column 13, lines 35-36, column 9, lines 60-65) connected to the computer (20); and c) a photoprinter (digital print system 10, column 7, line 55) connected to the computer (20) via the communication link, the photoprinter having means (22a, 22b, column 9, lines 30-55) for accessing the digital photographs (Column 9, lines 55-65, column 10, lines 27-37, column 12, lines 60-65).

Regarding claim 12: Itoh teaches a method for accessing digital photographs, (abstract) the method comprising the steps of: a) placing one or more digital photographs on a computer; (20, fig. 2, column 8, lines 20-35) b) establishing a communication link (the line connecting 20, server and 42 memory, column 9, lines 55-65, column 10 lines 27-37, fig. 1, column 13, lines 35-36, column 9, lines 60-65) between a photoprinter (digital print system 10, column 7, line 55) and the computer (20); c) inputting a request to the photoprinter by a user; (22a, 22b, column 9, lines 30-55, column 9, lines 55-65, column 10, lines 27-37) and d) accessing the digital photographs by the photoprinter in response to the request (Column 9, lines 25-67, column 12, lines 60-65).

Regarding claim 13: Itoh teaches wherein the step of accessing comprises downloading the digital photographs. (column 9, lines 60-65, column 12, lines 60-65).

3. Claims 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Colbert et al. (U.S. Patent # 5,699,494)

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Regarding claim 15: Colbert et al. teach a method for diagnosing a printer, (abstract, column 2, lines 25-35) the method comprising the steps of: a) obtaining a stand-alone printer; (16, fig. 1) b) establishing a communication link (21, fig. 1) between the stand-alone printer and a computer; (11, fig. 1) and c) transmitting instructions (commands, request, column 8 lines 1-20) over the communication link from the computer to the stand-alone printer; and d) diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions. (Column 9, lines 60-67, column 10, lines 1-45, abstract)

Regarding claim 16: Colbert et al. teach wherein the instructions comprise content to be presented on a display of the stand-alone printer. (Column 9, lines 60-67, column 10, lines 1-45, abstract)

Regarding claim 17: Colbert et al. teach the computer processing user inputs to the stand-alone printer. (Column 11, lines 65-67, column 12, lines 1-42)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh as applied to claim 1 above, and further in view of Satomi et al. (U.S. Patent # 4,759,053)

Regarding claim 8: Itoh does not teach wherein the communication link is a modem connections.

Satomi et al. teach to use a modem (7, fig. 1) connecting a computer (4, fig. 1) and a printing device, (1, fig. 10) as a communication link.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh to include: a modem connections as the communication link.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh by the teaching of Satomi et al. because of the following reasons: (a) it would have allowed the printer and the computer to be far apart and a user would still use the system; and (b) using a modem connection would have allowed the printer and the computer to be located at any location so long as there is a phone line and would have provided users with convenience.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh as applied to claim 9 above, and further in view of Bahreman (U.S. Patent # 6,061,665)

Regarding claim 10: Itoh does not teach wherein the data is accessible on an online account.

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Bahreman, in the same area of accessing data from a server (column 11, lines 50-55) from a client terminal, teaches data from a server is accessible on an online account. (Column 13, lines 45-50)

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh to include: the print data is accessible on an online account.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh by the teaching of Bahreman because of the following reasons: (a) it would have provided the account owner with privilege to use a system maintaining the account, as taught by Bahreman, at column 13, lines 45-50, and (b) it would have allowed users to secure electronic payment in exchange for accessing data over a communication network such as Internet, as taught by Bahreman, at column 1, lines 15-20, and column 11, lines 15-21)

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh as applied to claim 12 above, and further in view of Lightenberg et al. (U.S. Patent # 5,682,441)

Regarding claim 14: Itoh does not teach downloading thumbnail representations of the digital photographs.

Lightenberg et al, in the same area of transmitting images teaches downloading thumbnail representations of the digital photographs. (Column 12, lines 1-5, fig. 1, column 4, lines 15-30)

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Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh to include: downloading thumbnail representations of the digital photographs.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh by the teaching of Lightenberg et al. because of the following reasons: (a) it would have allowed a user to trade speed for image quality at will, as taught by Lightenberg et al, at column 12, lines 1-5, and (b) it would have consumed less CPU time and I/O resource that are only proportional to the thumbnail image data compare to a large image data, as taught by Lightenberg et al, at column 12, lines 1-5.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colbert et al. as applied to claim 15 above, and further in view of Itoh (U.S. Patent # 6,034,785).

Regarding claim 18: Colbert et al do not teach wherein the stand-alone printer is a photoprinter.

Itoh, in the same area of printing images from a computer (20, fig. 2, column 12, lines 41) to a stand alone printer (controller 14, and printer 16, column 6, lines 4-40), teaches that the stand-alone printer is a photoprinter. (Column 2, lines 55-67)

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Colbert et al. to include: a photoprinter as the stand alone printer.

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It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Colbert et al. by the teaching of Itoh because of the following reasons: (a) it would have allowed a user to print postal card on which a photograph is printed such as New Years cards, notice of marriage cards, as taught by Itoh at column 1, lines 15-20, and (b) it would have allowed the user to easily, accurately and effectively creating the cards, as taught by Itoh at column 3, lines 10-12.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colbert et al. as applied to claim 15 above, and further in view of Overall et al (U.S. Patent # 5,797,061).

Regarding claim 19: Colbert et al. do not teach the computer receiving usage statistics of the stand-alone printer.

Overall et al., in the same area of printing images from a host to a printer, teach to have the computer receiving usage statistics of the printer. (Column 18, lines 15-50)

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Colbert et al. to include: having the computer to receive usage statistics of the stand-alone printer.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Colbert et al. by the teaching of Overall et al. because of the following reasons: (a) the computer would display the predicted number of pages remaining based on the printer's usage statistics, as taught by Overall et al. at abstract.

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Response to Arguments

10. Applicant's arguments filed 1/7/2002 have been fully considered but they are not persuasive.

With respect to applicant's argument that Itoh does not teach a photoprinter, have been fully considered but they are not persuasive.

In reply: Column 6, lines 4-35, Itoh teaches that digital print system 10 is used to print images recorded on a film. Column 2, lines 35-45 Itoh further teaches that digital print system used to print images recorded on a film is a photoprinter/system. Therefore, the digital print system 10 is a photoprinter.

With respect to applicant's argument that Itoh fail to teach a stand-alone appliance for printing digital photographs, have been fully considered but they are not persuasive.

In reply: Stand-alone is not a limitation in the claims 1-14.

With respect to applicant's argument that Itoh does not teach a photoprinter having a selection means, which allows access to data over a communication link in response to users' input, have been fully considered but they are not persuasive.

In reply: Column 9, lines 25-55 Itoh teaches to use a mouse and display (selections) to select background images. Column 9, lines 20-25 Itoh teaches the background images are located in memory device 20 which is a server according to column 12, lines 35-41, Itoh. Therefore, Itoh teaches a photoprinter having a selection means, which allows access to data over a communication link in response to users' input.

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With respect to applicant's argument that Colbert does not diagnose a printer, have been fully considered but they are not persuasive.

In reply: Abstract of Colbert teaches users can access all data available of the printer. The examiner view that the accessing data of the printer is diagnosing the printer.

With respect to applicant's argument that Colbert does not teach a stand alone printer, have been fully considered but they are not persuasive.

In reply: Fig. 3, Colbert teaches a diagram of the controller of the printer. Column 11, lines 55-67, Colbert further teaches that the printer controller would process the print job independent from a host. Therefore, Colbert teaches a stand alone printer.

11. ACTION IS FINAL

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTHS shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892 or to Supervisor Mr. David Moore whose phone number is (703) 308-7452.

A handwritten signature in cursive script that reads "Gabriel Garcia".

**GABRIEL GARCIA
PRIMARY EXAMINER**

March 4, 2002